



UNITED STATES
PATENT AND
TRADEMARK OFFICE

UNDER SECRETARY OF COMMERCE FOR INTELLECTUAL PROPERTY
AND DIRECTOR OF THE UNITED STATES PATENT AND TRADEMARK OFFICE
WASHINGTON, D.C. 20231
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#14

In re Application of :
Antonio J. Grillo-Lopez et al. :
Serial No.: 09/436,348 : PETITION DECISION
Filed : November 11, 1999 :
Attorney Docket No.: :

This is in response to applicants' petition under 37 CFR 1.137(b) which is being treated as a petition under 37 CFR § 1.181, filed February 28, 2002, requesting revival of the above-identified application based on non-receipt of an Office action.

A review of the file history shows the examiner mailed a first Office action to applicants at the mailing address of Burns, Doane, Swecker & Mathis in Alexandria, Virginia. Applicants filed a reply which included a change of power of attorney to Robin Teskin, Shaw Pittman, 2300 N Street, NW, Washington, D.C. 20037-1128, on October 2, 2000 and an amendment having the same return address on October 13, 2000. Accordingly, the Office mailed the next Office action on February 9, 2001, to applicants at the new address. Applicants' attorney states that on November 28, 2000, she moved to the above listed firm and therefor never received the Office action mailed February 9, 2001. However, applicants did not file a change of Power of Attorney to the above firm, or change the mailing address, until July 9, 2001 (accepted July 26, 2001). A Notice of Abandonment as mailed to applicants at the above firm on October 1, 2001. This petition was then filed five months later.

This petition could be dismissed as untimely as 37 CFR 1.181 requires that such petition be filed within two months of the action complained of. However, to advance the prosecution of this application it is being treated on the merits.

From the above recitation of facts it is clear that mailing address of this application has changed following each communication to the Office. Filing of the application was by the firm of Burns, Doane, Swecker & Mathis; reply to the first Office action came from the firm Shaw Pittman; the petition is from the firm of Pillsbury Winthrop. However, the same attorney has prosecuted the application from each of these firms. It is noted that following the first Office action a new Power of Attorney was submitted prior to the reply being made. The new Power of Attorney and change of mailing address submitted most recently was filed almost seven months after applicant's attorney changed firms. The delay in submission of the new attorney's address resulted in the Office action being mailed to the old address. Applicant's attorney provides no evidence of non-receipt of the Office action as required by M.P.E.P. 711.03(c) which states:

To minimize costs and burdens to practitioners and the Office, the Office has modified the showing required to establish nonreceipt of an Office action. The showing required to establish nonreceipt of an Office communication must include a statement from the practitioner stating that the Office communication was not received by the practitioner and attesting to the fact that a search of the file jacket and docket records indicates that the Office communication was not received. A copy of the docket record where the nonreceived Office communication would have been entered had it been received and docketed must be attached to and referenced in the practitioner's statement. For example, if a three month period for reply was set in the nonreceived Office action, a copy of the docket report showing all replies docketed for a date three months from the mail date of the nonreceived Office action must be submitted as documentary proof of nonreceipt of the Office action. See Notice entitled "Withdrawing the Holding of Abandonment When Office Actions Are Not Received," 1156 O.G. 53 (November 16, 1993).


Clearly the docket records or mail logs to establish non-receipt of the Office action in question would be from applicant's attorney's previous firm. If such records do show receipt of the Office action there must also be an explanation as to why the Office action was not forwarded to applicant's attorney at the new firm.

The Request to Withdraw Abandonment under 37 CFR § 1.181 is **DISMISSED** without prejudice to applicant submitting a renewed petition. **Any renewed petition under 37 CFR 1.181 or under 37 CFR 1.137 must be filed within TWO MONTHS of the date of mailing of this decision.**

The reply to the outstanding Office action has been received and will be entered in the file.

No petition fee is required for this petition. Accordingly the petition fee paid of \$130.00 will be credited to applicants' credit card.

Should there be any questions with respect to this decision, please contact William R. Dixon, Jr., by mail addressed to Director, Technology Center 1600, Washington, D.C. 20231, or by telephone at (703) 308-3824 or by facsimile transmission at (703) 305-7230.



Bruce M. Kisliuk

Director, Technology Center 1600